REMARKS

The Office Action mailed December 26, 2007, has been received and reviewed. In the Office Action, claims 1-33 were pending in the subject application. All claims were rejected. More specifically, claims 1-31 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,814,510 to Sabbagh et al. (hereinafter the "Sabbagh reference") in view of U.S. Patent No. 7,168,003 to Lozano et al. (hereinafter the "Lozano reference"). Claim 32 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Sabbagh reference in view of the Lozano reference and in further view of U.S. Patent Application No. 2002/0188646 to Terrill et al. (hereinafter the "Terrill reference"). Reconsideration of the present application in view of the above amendments and the following remarks is respectfully requested.

Rejections based on 35 U.S.C. § 103

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestion or motivation found either in the prior art references themselves or in the knowledge generally available to one

of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See, *Application of Bergel,* 292 F. 2d 955, 956-957 (1961). Thus, in order "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." *See* MPEP § 2143. Recently, the Supreme Court elaborated, at pages 13-14 of *KSR*, it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application]." *KSR v. Teleflex*, 127 S. Ct. 1727 (2007).

Claims 1-31 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Sabbagh reference in view of the Lozano reference. Applicants respectfully submit that the cited references, either alone or in combination, fail to teach or suggest each of the required limitations of these claims, as proposed to be amended herein. Therefore, Applicants respectfully traverse the rejections, as hereinafter set forth.

As proposed to be amended herein, independent claim 1 recites a system for automatic configuration upon installation of a network printer. The system comprises, in part, bi-directional application program interfaces associated with the spooler for allowing the driver to generate a request and a response, the bi-directional application program interfaces configured

to seek a *list of one or more installable features* upon installation of the network printer. Further, the bi-directional application program interfaces are configured to perform an *auto-configuration* of the system upon installation of the network printer, the auto-configuration including configuration of the one or more installable features. As stated in the specification, independent claim 1 provides for "automatically updating a system configuration upon installation of a network printer . . ." *See Specification* at p. 19, ¶ [0055].

By way of contrast, as previously discussed, the Sabbagh reference is directed to updating printer drivers. *See generally Sabbagh reference.* Not only does the Sabbagh reference fail to provide auto-configuration upon installation of a network printer, but also, as previously discussed, the Sabbagh reference fails to disclose bi-directional communication through a syntax extension to existing printer description files. *See generally Sabbagh reference.* The addition of the Lozano reference does not cure these deficiencies. *See generally Lozano reference.* Instead, the Lozano reference merely discloses a program for performing printer communication diagnostics after a user has selected one or more printers to be tested. *See, e.g., Lozano reference* at Abstract; Col. 3, ll. 29-53; Col. 9, ll. 1-5. The testing functionality of the Lozano reference does include seeking installed printers on a network. *See generally Lozano reference.* But seeking out installed printers after they have been identified by a user for testing is vastly different from the auto-configuration of a network printer upon installation, as required by independent claim 1. Accordingly, Applicants respectfully submit that the Sabbagh and Lozano references, either alone or in combination, fail to teach or suggest each of the limitations of independent claim 1, as proposed to be amended herein, under 35 U.S.C. § 103(a). Thus, claim 1 is patentable over the Sabbagh and Lozano references. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection of this claim is respectfully requested.

With reference to claim 10, a system for facilitating client retrieval of bi-directional information upon installation of a network device is recited that comprises, in part, a set of bi-directional constructs within a printer description file. As previously discussed, neither the Sabbagh reference nor the Lozano reference, alone or in combination, teach or suggest auto-configuration of a system upon installation of a network printer, as required by independent claim 10, as proposed to be amended herein. Nor do the cited references teach or suggest auto-configuration where the auto-configuration provides for automatically updating the system upon installation of the network printer without user intervention. Accordingly, Applicants respectfully submit that the Sabbagh and Lozano references, either alone or in combination, fail to teach or suggest each of the limitations of independent claim 10, as proposed to be amended herein, under 35 U.S.C. § 103(a). Thus, claim 10 is patentable over the Sabbagh and Lozano references. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection of this claim is respectfully requested.

With reference to claim 21, a method is recited for automatically configuring a system upon installation of a network printer within the system, wherein the system includes printer description files, a driver, a spooler, and a port monitor which comprises, in part, getting a list of installable features and corresponding bi-directional requests from the printer description files. As previously discussed, neither the Sabbagh reference nor the Lozano reference, alone or in combination, teach or suggest auto-configuration of a system upon installation of a network printer, as required by independent claim 21, as proposed to be amended herein. Accordingly, Applicants respectfully submit that the Sabbagh and Lozano references, either alone or in combination, fail to teach or suggest each of the limitations of independent claim 21, as proposed to be amended herein, under 35 U.S.C. § 103(a). Thus, claim 21 is patentable over the Sabbagh

and Lozano references. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection of this claim is respectfully requested.

With reference to claim 31, a method is recited for providing extensibility for a port monitor in order to enable vendors to define new mappings using existing public bi-directional schema and extensions to existing schema which comprises, in part, permitting the use of an extension file capable of describing a mapping between bi-directional values and device-specific objects. As previously discussed, neither the Sabbagh reference nor the Lozano reference, alone or in combination, teach or suggest auto-configuration of a system upon installation of a network printer, as required by independent claim 31, as proposed to be amended herein. Accordingly, Applicants respectfully submit that the Sabbagh and Lozano references, either alone or in combination, fail to teach or suggest each of the limitations of independent claim 31, as proposed to be amended herein, under 35 U.S.C. § 103(a). Thus, claim 31 is patentable over the Sabbagh and Lozano references. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection of this claim is respectfully requested.

As the Sabbagh and Lozano references, either alone or in combination, fail to teach or suggest every element of independent claims 1, 10, 21, and 31, it is respectfully submitted that these claims are patentable over the Sabbagh and Lozano references. Each of claims 2-9, 11-20, 22-30, and 33 depends, either directly or indirectly, from one of claims 1, 10, 21, and 31 and is, accordingly, patentable over the Sabbagh and Lozano references for at least the above-cited reasons. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of claims 2-9, 11-20, 22-30, and 33 is respectfully requested.

Claim 32 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Sabbagh reference in view of the Lozano reference and in further view of the Terrill reference.

As the Sabbagh, Lozano, and Terrill references, either alone or in combination, fail to teach or suggest each of the elements of claim 32, Applicants respectfully traverse this rejection as hereinafter set forth.

Claim 32 depends from claim 31 which recites, in part, a method for providing extensibility for a port monitor in order to enable vendors to define new mappings using existing public bi-directional schema and extensions to existing schema which comprises, in part, permitting the use of an extension file capable of describing a mapping between bi-directional values and device-specific objects. As previously discussed, neither the Sabbagh reference nor the Lozano reference, alone or in combination, teach or suggest auto-configuration of a system upon installation of a network printer, as required by independent claim 31, as proposed to be amended herein. The deficiencies of the Sabbagh and Lozano references are not overcome by the addition of the Terrill reference which monitors pre-print and post-print information and utilizes XML. *See generally Terrill reference.* Thus, Applicants respectfully submit that the Sabbagh, Lozano, and Terrill references, either alone or in combination, fail to teach or suggest each of the limitations of dependent claim 32 under 35 U.S.C. § 103(a). Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection of this claim is respectfully requested.

CONCLUSION

For at least the reasons stated above, claims 1-33 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of claims 1-33. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action.

No other fee is believed due in connection with this Amendment, but the Commissioner is hereby authorized to charge any additional amount required or to credit any overpayment to Deposit Account No. 19-2112, referencing attorney docket number MFCP.103203.

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Respectfully submitted,

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